# REMARKS

Applicants appreciate the Examiner's thorough consideration provided the present application. Claims 1-10 are present in the application. Claim 1 has been amended. Claims 6-10 have been added for the Examiner's consideration. Claims 1 and 6 are independent. Reconsideration of this application, as amended, is respectfully requested.

**Rejection Under 35 U.S.C. § 101**

Claims 1-5 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner asserts that the claimed invention is non-statutory because it does not accomplish a useful, concrete and tangible result. Specifically, the Examiner asserts that since the job is not necessarily being executed, there is no useful result. The Examiner also asserts that the actual job execution is the tangible result. Applicants disagree with the Examiner's position. The determination of the path is the useful result in the presently claimed invention, not the carrying out of the job. For at least this reason, the Examiner's rejection is improper and should be withdrawn.

In addition, the Examiner has ignored the fact that the present claims include elements that are clearly statutory. For example, claim 1 recites "user interface means." A user interface means is clearly a "machine" that would be considered statutory subject matter (see MPEP 2106 IV).

In view of the above remarks, Applicant respectfully submits that claims 1-5 are directed to statutory subject matter. Reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 101 are therefore respectfully requested.

## Rejection under 35 U.S.C. § 112

Claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Examiner states "it is unclear whether it is a system claim or a means plus function claim." Applicant does not understand what the Examiner believes to be indefinite. A <u>claim</u> cannot be defined as a system <u>claim</u> or a means plus function <u>claim</u>. Only an <u>element</u> in a claim can be presented in means plus function format or not. In the present situation, claim 1 is directed to "a distributed document handling system." Therefore, claim 1 is clearly a "system" claim. However, claim 1 also includes several elements that are presented in means plus function format. For example, claim 1 recites "specifying means for entering by a user a job specification." There is no question that this recitation has been presented in means plus function format. Therefore, it is not understood what the Examiner considers to be indefinite.

In view of the above, Applicant respectfully submits that claims 1-5 are definite and clear. Therefore, reconsiderations and withdrawal of the Examiner's rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

## Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102 as being anticipate by Whitmarsh et al., U.S. Patent No. 7,042,585. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Whitmarsh et al. in view of Nakajima, U.S. Application Publication No. 2002/0107817. These rejections are respectfully traversed.

At the outset, it is noted that the Whitmarsh et al. reference has an effective filing date of October 10, 2000 in view of its filing date. The Whitmarsh et al. reference has a publication date of May 9, 2006, which is after the filing date of the present application of October 12, 2001. In view of this, the Whitmarsh et al. reference is not available as a reference under 35 U.S.C. § 102(b), but is only available as a reference under 35 U.S.C. § 102(e). In view of this, the Examiner's rejection in view of the Whitmarsh et al. reference is misstated.

In addition, it is noted that the present application claims priority to EPO Application No. 00203538.4, which was filed on October 13, 2000, which is only three days after the effective filing date of the Whitmarsh et al. reference. It is believed that the below amendments and remarks should be sufficient to overcome the Whitmarsh et al. reference. However, if the Examiner persists in the rejection of the claims in view of the Whitmarsh et al. reference, Applicant reserves the right to antedate the Whitmarsh et al. reference by showing an earlier invention.

In any event, the present invention is directed to a distributed document handling system, wherein a combination of elements are presented in claim 1 including "determining means for determining a path of services, a path comprising at least two services, the services being

selected from the pool of services, wherein the path is suitable to carry out the job in accordance with the product specifications." Applicant respectfully submits that the Whitmarsh et al. reference fails to teach or suggest this aspect of the present invention.

Referring to Figure 1 of Whitmarsh et al., a customer 14 uses a print brokering system to determine a print provider 16 that is capable of performing a particular print job 12. The print brokering system controller 28 considers circumstantial constraints such as price to determine whether a particular print provider 16 should be utilized to perform a particular print job 12. However, in all circumstances, only one print provider 16 is used to execute a particular job 12. This is a major difference between Whitmarsh et al. and the presently claimed invention.

Specifically, in Whitmarsh et al., a "path of services" as meant in claim 1 is lacking. Whitmarsh et al. only discloses a plurality of print providers 16, each print provider supplying print services 18. However, a customer selects only one of the print providers 16 from the plurality of print providers 16. In mapping the disclosure of Whitmarsh et al. to the presently claimed invention, one could argue that Whitmarsh et al. discloses three paths (each leading to one of the services 18a, 18b and 18c in Figure 1), each path with a length of 1. The blocks inbetween the job submitter and the print services 16 are not services as in the presently claimed invention. A major difference between the presently claimed invention and Whitmarsh et al. is that in Whitmarsh et al. only one print provider (and therefore only one service) is accessed by the customer. In the present invention; however, a path of services is selected from a pool of services in order to walk through and carry out the print job of the customer.

It should be noted that each one of the print providers may supply more than one service; however, these services are not disclosed by Whitmarsh et al. as being "distributed over a number of interconnected processing devices" as in the presently claimed invention. Therefore, Whitmarsh et al. does not disclose a pool of services, but only discloses a pool of print providers. The system of Whitmarsh et al. is therefore quite different from the presently claimed invention.

In order to further define the present invention over the Whitmarsh et al. system, claim 1 has been amended to recite "a path comprising at least two services." Since the Whitmarsh et al. system never utilizes more than one print provider 16 to execute a particular print job 12, Whitmarsh et al. fails to anticipate independent claim 1 of the present invention.

In Whitmarsh et al., one print provider 16 provides all of the print services 18. Otherwise, the print job request will be rejected. According to the presently claimed invention; however, a path will be determined by combining services in a sequence that will fulfill the requirements of the user as good as possible. For example, to indicate the difference between Whitmarsh et al. and the presently claimed invention, suppose the situation of a CAD file that has to be printed on a machine that is only capable of printing jpeg files. According to Whitmarsh et al., printing is not possible. According to the presently claimed invention; however, a path will be made of a conversion service (A) to convert the CAD file (.dwg) to the jpeg format (.jpg) and a jpeg printing service (B) (supposing that these services are available in the pool of services). This path of services could be indicated as the path (A)-(B).

Of course, this is a simple example only to illustrate the differences of Whitmarsh et al., but much more ingenious paths are possible. For example, where at first sight services seem to be counterproductive, but looking integrally over a whole path the combination is preferred.

For example, considering the example above, but now also a conversion service (C) is available for conversion from the .dwg format to the .png format to the .jpg format. Therefore, the system according to the present invention will also provide a path along the services (C)-(D)-(B). If the service (A) is very slow and the services (C) and (D) are fast and a time constraint is defined for the job, the user may select the path (C)-(D)-(B) for carrying out the job. The crux of the present invention is that constraints for all involved services, along a path, are taken into account, and the costs of alternative paths are compared. Thus, constraints for a single service on its own are not evaluated and compared as disclosed in Whitmarsh et al. This leads to advantages not attainable by the disclosure of Whitmarsh et al.

It should be emphasized that a major difference between the presently claimed invention and Whitmarsh et al. is that at least two services are used to carry out a particular print job, each of the services being distributed over a number of interconnected processing devices. Therefore, the above advantages are not attainable by the system of Whitmarsh et al.

A system according to the present invention is based on a sequence of services that is much more flexible in the deployment of a variety of resources than a system according to Whitmarsh et al.. Therefore, the notion of "path" according to the present invention is different from the notion of "path" as disclosed in Whitmarsh et al. This distinction leads to the above-

mentioned advantages of the presently claimed invention that are not attainable by Whitmarsh et al.

The Examiner also asserts that Whitmarsh et al. discloses user interface means for, after the paths have been presented, enabling modification of the job specification by the user. The Examiner refers to column 5, lines 48-61 and column 11, lines 14-39 of Whitmarsh et al. However, what is disclosed there is that parameters of the service are distinguished in static parameters and in dynamic parameters. Static parameters remain fixed and are coupled to the configuration/capabilities of a machine. That will not change in time often. The dynamic parameters are parameters that may be dependent on actual circumstances, e.g. a required start time, for the job. In is only disclosed there that these dynamic parameters will also be presented to the user. However, there is no disclosure in Whitmarsh et al. of a user interface means that enables modifications of the job specification of the user as recited in claim 1. Therefore, Whitmarsh et al. fails to anticipate independent claim 1 of the present invention for this additional reason.

With regard to dependent claims 2-5, Applicant respectfully submits that these claims are allowable due to their dependence on independent claim 1, as well as due to the additional recitations in these claims.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1-5 clearly define the present invention over the references relied on by the Examiner. Reconsideration and withdrawal of the Examiner's rejections under 35 U.S.C. §§ 102 and 103 are respectfully requested.

Birch, Stewart, Kolasch & Birch, LLP

PCL/cl

**Additional claims**

Additional claims 6-10 have been added for the Examiner's consideration. Claims 6-10 have been presented, so that none of the elements of the claims are in means plus function format. Applicants respectfully submit that claims 6-10 are allowable for generally the same reasons mentioned above with regard to claims 1-5.

Favorable consideration and allowance of additional claims 6-10 are respectfully requested.

## CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

Birch, Stewart, Kolasch & Birch, LLP

PCL/cl

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By
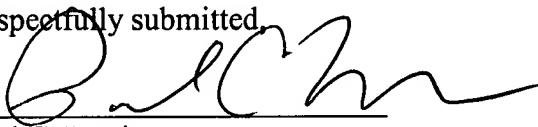
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